

Serial No. 09/507,466  
Reply to Office Action dated March 16, 2004

Docket No. MEMS-0253-US

### **REMARKS/ARGUMENTS**

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 1-3, 6-10, and 12-22 are pending in the application. Claims 19-22 have been added.

### **Specification Informalities**

The specification was objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. The Examiner has indicated, and Applicant acknowledges, that "an optical device having a substrate with a smooth regularly shaped exterior surface and an irregularly shaped exterior output surface" is supported by the drawings. However, the Examiner alleges that the specification has not provided positively provided support. The Examiner indicates that the Applicant should amend the specification (Office Action 16 March 2004, page 2). Applicant directs the Examiner to the amended specification which describes the exterior surface and exterior output surface. Accordingly, withdrawal of this objection is respectfully requested.

### **Claim Objections and 35 U.S.C. § 112 Rejections**

Claims 1-3 and 6-8 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter set forth therein. Each of the formalities identified in the Office Action has been addressed in this Amendment, and Applicant accordingly requests the Examiner to reconsider and withdraw this rejection.

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### **Allowable Subject Matter**

Applicant notes with appreciation the indication on page 7 of the Office Action that claims 12-18 are allowed.

### **Prior Art Rejections**

#### **1. Rejection under 35 U.S.C. § 102 (b) based on Chahroudi**

Claims 1-3 and 8-10 stand rejected under 35 U.S.C. §102(b) as anticipated by Chahroudi (U.S. Patent No. 5,198,922). This rejection is respectfully traversed.

Applicant directs the Examiner's attention to amended claims 1 and 9. Amended claim 1 states "said incident light beam exiting the irregularly shaped exterior output surface via the second optical element in a predetermined second direction in the medium different from said predetermined first direction in the medium" and claim 9 states "the substrate adjacent to a medium, ...where at least two adjacent optical elements direct the light exiting into two different predetermined directions in the medium."

Chahroudi is directed to an optical shutter structure comprising an optically rough layer of an optically thin optical shutter, and two additional layers disposed on either side of the optical shutter. The two additional layers have refractive indices which approximately match (Chahroudi, Abstract). A ray of light 7 passing through the optical shutter 1 will not be significantly deflected (Chahroudi, col.3, ll. 7-9). Thus, Chahroudi fails to show light exiting an irregularly shaped exterior surface in "a predetermined second direction in the medium different from said predetermined first direction" and therefore fails to show an element of claims 1 and 9.

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For anticipation under 35 U.S.C. § 102 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)(M.P.E.P. 2131). For reasons stated above applicants assert that all of the elements of claims 1 and 9 fail to be set forth in the embodiment shown in Chahroudi and, thus, Chahroudi fails to anticipate claims 1 and 9.

Applicant has already explained why Chahroudi fails to teach or suggest the invention of independent claims 1 and 9. Since claims 2-3, 8, and 10 each depend, either directly or indirectly, from one of claim(s) 1, and 9, claims 2-3, 8, and 10 are allowable at least for the reasons generally expressed above with respect to claim(s) 1, and 9.

If this rejection is maintained, Applicant respectfully requests that the Examiner indicate with specificity, where each claim feature is allegedly shown in the prior art.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 102(b) based on Chahroudi.

## 2. Rejection under 35 U.S.C. § 103 (a) based on Tedesco in view of Chahroudi

Claims 1-2 and 8-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tedesco (U.S. Patent No. 5,861,990) in view of Chahroudi. This rejection is respectfully traversed.

Tedesco is directed toward a concentrator and diffuser of incident light exiting an output surface (Tedesco, Abstract). The structure in Tedesco is characterized as having random size/slope distribution (Tedesco, col. 3, ll. 34-35). Chahroudi is directed

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toward an optical shutter that does not diffuse incident light exiting an output surface. Thus the system of Tedesco would frustrate the purpose of Chahroudi and therefore teaches away from combining the system of Tedesco with Chahroudi.

To establish obviousness based on the combination of elements disclosed in the prior art there must be some motivation, suggestion, or teaching, and the desirability of making the specific combination that was made by the Applicant, "[i]t is improper to combine references where the references teach away from their combination" (M.P.E.P. § 2145; *In re Grasselli*, 218 USPQ 769 (Fed. Cir 1983)). The motivation, suggestion, or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See *Dembiczak*, 50 USPQ2d at 1617. Broad conclusionary statements standing alone are not "evidence." Thus, there is a lack of suggestion or motivation to combine Tedesco and Chahroudi.

Accordingly Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims since claims 1-2 and 8-10 under 35 U.S.C. § 103(a).

3. Rejection under 35 U.S.C. § 103 (a) based on Tedesco and Chahroudi in view of Hoch

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tedesco in view of Chahroudi as applied to claim 1 and further in view of Hoch et al. (U.S. Patent No. 6,002,520). This rejection is respectfully traversed.

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As discussed above Chahroudi lacks motivation for combination with Tedesco and both fail to suggest, teach, or show all elements of claim 1 independently. Hoch fails to show, suggest, or teach the missing elements. Thus, Chahroudi and Hoch (assuming both are combinable, which Applicant contests) and Tedesco and Hoch (assuming both are combinable, which Applicant contests) fails to suggest all the elements of claim 1. Thus claims 6 and 7, dependent on claim 1, define over the art of record.

Accordingly Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims since claims 6 and 7 under 35 U.S.C. § 103(a).

### **New Claims**

New claims 19-22 are added to this application and further define the inventive features supported by the present application. Neither Chahroudi, Tedesco, nor Hoch illustrates a first light beam exiting a first portion in a predetermined first direction, and the second portion directing a second light beam exiting the second portion in a predetermined second direction, the first light beam and second light beam contributing to a portion of a predetermined pattern.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the

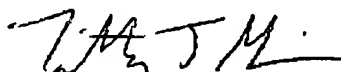
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Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3136 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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